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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/622,668

07/21/2003

Yasuhiro Yoshioka

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TAIYO CORPORATION

401 HOLLAND LANE

#407

ALEXANDRIA, VA 22314

EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/622,668

Applicant(s)

YOSHIOKA ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,9,11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20070319.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to applicants' response and petition for review on November 29, 2006; Claims 1,3,5,7,9,11 and 13-17 are pending in this instant application.

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/695,864, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In this case, the prior-filed application, Application No. 09/695,864 fails to provide support for the claimed invention. See the language in claims 1, 3, 5, 7, 9, 11, 13-17 in view of the prior-filed application.

See MPEP 2233.1 "when applicant files a continuation-in-part whose claims are not supported by the parent application, the effective date is the filing date of the child CIP. Any prior art disclosing the invention or an obvious variant thereof having a critical reference date more than 1 year prior to the filing date of the child will bear the issuance of a patent under 35 USC 102(b). *Paperless Accounting v. Bay Area Rapid Transit system*, 804 F. 2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).".

In this case, the prior-filed application fails to provide support for the combination of the compound of formula R1 does not for a dye and R2 which form a dye claimed in the present claimed invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 7, 9, 11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 10096310 (EP'310).

The EP'310 discloses a photothermographic material substantially as claimed. The photothermographic material contains one or more bisphenols compound having formula encompass the scope of formula (R1) and (R2) of the present claimed invention. See the generic phenol compound on page 3, [0013], compound (I) and the description of -L- and R1 to R8 on page 5 such as L is -CHR⁹-, R9 is hydrogen or alkyl; R1, R8 represent secondary alkyl group or a tertiary alkyl group; R2, R4, R5, R7 represent hydrogen, halogen, or an alkyl group, more preferably hydrogen; R1, R3, R6, R8 represent an alkyl group, more preferably, a primary group having 1-20 carbon atoms, a secondary alkyl group having 3-20 carbon atoms, or tertiary group having 4-20 carbon atom, and the substituent thereof includes alkoxy group, aryloxy group, hydroxyl group, acyloxy group, amino group, heterocyclic group. The compound of formula (I) is exemplified on page 7, compound (I-6), wherein a tertiary alkyl as R1 and R8; an alkyl having 4 carbon atoms as R3 and R6; and an alkyl group (-CH₃) associated with L. This

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compound is within the scope of formula (R1) of the present invention. The compound of formula (I-4), (I-9) or (I-10) are within the scope of formula (R2) of the present claimed invention. On page 5, [0034] to [0037], it is disclosed that "preferably R1 and R8 independently represent a secondary alkyl group or a tertiary alkyl group. If a secondary alkyl group or tertiary alkyl group is selected, coating amount can be markedly reduced, and hence the production cost of the photothermographic material and labors may be markedly reduced. Further, if secondary alkyl group or tertiary alkyl group is selected, image storability is extremely degraded, unless a compound having a phosphoryl group is used in combination. However, by using them in combination according to the present invention, the image storability is markedly improved. In view of development activity, tertiary alkyl groups are preferred as R1 and R8. While R1 and R8 may be identical or different, they are preferably identical to each other. R3 and R6, unsubstituted alkyl groups are preferred. Specific example includes methyl group, ethyl group, propyl group, butyl group, t-butyl group, t-amyl group, cyclohexyl group, 1-methylcyclohexyl group and so forth. More preferred are methyl group, ethyl group, isopropyl group and t-butyl group, and most preferred are methyl group and ethyl group. Preferably, R2, R4, R5 and R7 independently a hydrogen atom, a halogen atom or an alkyl group, more preferably hydrogen group. L represent a group -S- or a group -CHR⁹- where R⁹ represent a hydrogen or alkyl group. See the other additive such as compound having phosphoryl group on pages 20-34; the halogenated compound on pages 60, [0242], [0243]; the amount of reducing agent on pages 11, [0039], [0040]; the amount of silver salt on page 35, [0074]; the toning agent and the ultrahigh contrast developer on page 41; the hydrazine derivative on page 49, [0167], [0168]; and time and temperature processing on page 53, [0210].

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EP'310 discloses the use of one or more "o-polyphenol compound", and herein the "o-polyphenol compound" taught therein encompasses the scope of the compound of formula (R1) and (R2) claimed in the present claimed invention. The compound has different activity accordingly to the substituent associated therein. See for instance the compound having tertiary alkyl groups in R1 and R8 is used for development activity. Therefore, It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use one or more compound within the scope of formula (I) of EP'310 with an expectation of achieving a highly useful material with sufficient image density and image storage stability.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 10096310 (EP'310) as applied to claims 1, 3, 5, 7, 9, 11, 13-17 above, and further in view of Oya et al (US 2001/0051319A1).

Oya et al discloses the compound within the scope of formula (A-2) in claim 7 as development accelerator of a photothermographic material. See compound of formula (2) in the abstract. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Oya et al as development accelerator for the material of EP'310, and thereby provide a material as claimed.

Response to Arguments

5. Applicant's arguments filed November 29, 2006 have been fully considered but they are not persuasive because of the rejection of claims 1, 3, 5, 7, 9, 11, 13-17 under 35 U.S.C. 103(a) as being unpatentable over EP 10096310 (EP'310) is maintained due to the prior-filed application fails to provide support the invention now being claimed, and for the reason set forth in response to the applicants' argument on June 1, 2006 in reference to the EP'310.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *tc*
2007-04-25

Thorl Chea
Thorl Chea
Primary Examiner
Art Unit 1752